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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,442	09/08/2003	Dov L. Randall	0112300-1627	1420

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BELL, BOYD & LLOYD LLP
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CHICAGO, IL 60690

EXAMINER

RENDON, CHRISTIAN E

ART UNIT	PAPER NUMBER
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3714

NOTIFICATION DATE	DELIVERY MODE
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08/16/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

Office Action Summary

Application No.

10/657,442

Applicant(s)

RANDALL ET AL.

Examiner

Christian E. Rendón

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-67 are rejected under 35 U.S.C. 102(e) as being anticipated by Baerlocher et al. (US 2003/0036419 A1).

1. Regarding claims 1, 10, 18, 29, 37, 48, 56-58, 62 and 66-67, Baerlocher discloses a primary or triggered bonus game that randomly generates or selects a plurality of digits of an award (abstract). The game instructs the player to use the digits to create a range of possible awards or offers (fig. 3b) therefore the digits are viewed as offer components. The game machine's processor is programmed to select several numbers for activation as offer components (par. 10, lines 5-6). After the player determines a position for each masked number or offer component an offer is created based on all of the selected award values (par. 10, lines 10-12). At this point the player is given a choice to accept or reject the offer (par. 18, lines 1-3). The preferred embodiment of the game randomly decides on a modification method to apply on the award when the player rejects the offer (par. 19, lines 2-5). The

included modification methods that change the state of an offer component are scrambling the digits, regenerating the award, subtracting or adding a digit and multiplying an award (par. 19, lines 6-9). The regeneration of the award is the only modification that is viewed as a "change of selection of a number of said selected offer components" as described in claims 18 and 29. The subtraction of a digit is the only modification that unselects a number or offer component based on the number or value of the component (par. 22, lines 5-7), therefore it is viewed as a modifier associated with a negative value or effect because of the impact it creates is undesirable (par. 130, lines 6-10). The addition of a digit (par. 125, lines 11-12) and the multiplication of the award (par. 135, lines 7-8) will always increase the award and are both highly desirable since the modifiers are associated with a positive value or effect. Once the modification process is complete a new award is available for the player (par. 114, lines 6-7).

2. Regarding claim 2, 11, 19, 30, 38, 49, 61 and 65, figure 8 of the prior art demonstrates the occurrence of an event that allows the player to accept [keep] (fig. 8, 166) or reject [modify] (fig. 8, 164) an offer provided by the preferred embodiment (par. 19, lines 2-5).

3. Regarding claims 3-4, 12, 20-21, 31, 39-40 and 50-51, in one of the preferred embodiments the game displays three masked numbers (Fig. 3B, 116) (par. 56, lines 6-8) or offer components since each one is a piece of a final offer. A player is allowed to decide how to organize the pieces or components by selecting or activating a masked number's digit location.

4. Regarding claims 5, 13, 22, 32, 41 and 52, the component number modifiers are initially masked since it is not revealed which modifier is selected until after the player makes the decision to modify the award (par. 131, lines 1-3).

5. Regarding claims 6-8, 14-16, 23-25, 33-35, 42-44 and 53-55, the prior art illustrates in figure 5 that a probability is associated with each masked number and is stored in a database (par. 77, lines 1-2). The numbers are all weighted differently and the game machine is programmed to assign 50%

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of the time 0-3 as an offer component (par. 78). Therefore a player is more likely to receive an award of lower value.

6. Regarding claim 9, 17, 26, 36 and 45, the game machine offers awards associated with each offer component and the total range of possible awards is equal to $^{10}P_3 = 720$.

7. Regarding claims 27-28, the prior art discloses a device having several modification methods at its disposal when a player selects to modify or reject the current award (par. 19, lines 2-5). Furthermore, the modifier is selected after the player selects or presses the modify button.

8. Regarding claim 46, the art discloses several possible modifiers that the game can select from and each possible modifier has a value or effect attributed to each one. As stated above, addition and multiplication always have positive effects, regeneration and scrambling are considered to have neutral effects since a player cannot allow depend on positive results and subtraction of a digit always has negative effects. Therefore the prior art discloses a game selecting a modifier from a range of effects or values.

9. Regarding claim 47, the prior art claims that each possible modifier is selected based on a probability stored in a memory device (par. 112, 119, 124, 129, 134, lines 1-3).

10. Regarding claims 59-60 and 63-64, the art discloses a modification that subtracts a digit, in other words unselects a number or offer component based on the number or value of the component (par. 22, lines 5-7). Since the value of an award is always lowered this modifier is associated with a negative value or effect and is considered very undesirable (par. 130, lines 6-10). Fortunately, the modifier unselects the number of the lowest value (par. 22, lines 5-7); therefore the offer component that contains the lowest number is associated with the negative value attributed to this modification.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian E. Rendón whose telephone number is 571-272-3117. The examiner can normally be reached on 9 - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christian E Rendón
Examiner
Art Unit 3714

CER

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SUPERVISORY PATENT EXAMINER

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